

## REMARKS

Reconsideration of this patent application is respectfully requested in view of the foregoing amendments, and the following remarks.

The Specification has been amended on page 1 to correct a minor typographical error.

The Patent Examiner rejected claims 18-34 under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for all of the following reasons:

(A) The preamble of claim 18 allegedly provides for ambiguity relative to the extraction step, i.e., whether to consider this step as part of applicants' invention or not?

For this reason, the preamble portion of claim 18 has been revised to be presented in a modified Jepson-type-format, and includes a wording for the preamble which is close to the disclosure on page 5 second paragraph of the Specification, as follows:

"Process for the separation and purification of a mixture comprising the main components acetic acid, formic acid, water and high boilers

by extraction by means of a solvent in a circulation process in a first step and a subsequently fractionation of an extract stream in a sequence of distillation steps, which comprises..."

(B) The term "pure" and "small" in claims 18 and 29 are relative terms, which allegedly render the claims indefinite. Replacing, the term "pure" with - purified - obviates this rejection.

In response to this objection, claims 18, 31 and 32 are being amended to cancel the term "pure" and to replace it with the word "purified". Claims 29 and 31 have been amended to cancel the phrase "small amounts of".

(C) In claim 29, "in such a way" is allegedly indefinite as the way has not been defined. In response to this objection, claim 29 has been amended to cancel the phrase "in such a way."

(D) The inconsistent use of terminology in the claims is improper. For example: "intermediate distillation column (29)" in claim 30 as opposed to "column (29)" in claim 18, the claim from which it depends. The same holds true for claims 31 and 33. See also the "solvent stripping column (11)" in claim 18 as opposed to solvent distillation column (11) in claim 33.

In response to these objections, claim 18 and claim 31 were each amended to recite "intermediate distillation column (29)." Claim 33 was amended to recite "solvent stripping column (11)." Thus the use of this terminology is now consistent in all of the claims.

(E) The Patent Examiner has contended that there is no proper antecedent basis in the claims for the following recitations:

- (1) "the formic acid distillation column (33)" in claim 33; This has been corrected by reciting in claim 33 "a formic acid".
- (2) "the heat of reaction", claim 34; This has been corrected by reciting in claim 34 "heat of reaction".
- (3) "the upstream reaction", claim 34; This has been corrected by reciting in claim 34 "an upstream reaction".
- (4) "the acetic acid distillation column (5)", claim 34; This has been corrected by reciting in claim 34 "an acetic acid".
- (5) "the formic acid distillation column (33)", claim 34; This has been corrected by reciting in claim 34, "a formic acid".

(F) The Patent Examiner has contended that the parenthetical expression in claim 34 renders the claim ambiguous i.e., whether or not the expression should be disregarded. In response to this objection, claim 34 has been amended to delete the terminology in parenthesis.

For all of these reasons, all the claims as amended are now in complete compliance with the requirements of 35 U.S.C. 112. Withdrawal of this ground of rejection is respectfully requested.

Claims 18 to 34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as

being unpatentable over claims 13-25 of copending U.S. Patent Application No. 10/030,533. Although the conflicting claims are not identical, they are not patentably distinct from each other because allegedly the subject matter of the instant claims is covered in the claims of the above copending application and vice versa.

This is a provisional obviousness-type-double patenting rejection because the conflicting claims have not in fact been patented.

The Patent Examiner has alleged that the subject matter claimed in the instant patent application is fully disclosed in the referenced copending patent application and would be covered by any patent granted on that copending patent application since the referenced copending patent application and the instant patent application are allegedly claiming common subject matter.

In response to this double patenting rejection, it is respectfully pointed out that the main difference between the instant patent application and S.N. 10/030,533 is that in a process according to S.N. 10/030,533 formic acid will already get separated in the solvent distillation column (8) via a side offtake, while in a process according to the present invention the formic acid will leave column (8) as a part of mixture (B) consisting essentially of acetic acid, high boilers and said formic acid, and

gets separated off later in the intermediate distillation column (29) from the acetic acid and high boilers.

Both patent applications could be considered under the concept of separating mixtures of liquids but differ essentially in the manner of separation in the "subsequently fractionation of the extract stream". Both applications deal with a similar separation problem but are alternative embodiments for the solution of this technical problem.

It is respectfully pointed out that both applications can be distinguished considerably by the feature "side-offtake at column (8)" and a process according to S.N. 10/030,533 would never be covered by the claims of the present application and vice versa, due to lack of presence of said feature "side-offtake".

For all the reasons set forth above, it is firmly believed that the inventions of S.N. 10/009,507 and S.N. 10/030,533 are patentably distinct, and clearly distinguish each application from the other, based upon these nonobvious recited limitations in the claims. Withdrawal of this double patenting ground of rejection is respectfully requested.


In summary, claims 18 to 34 are pending, and claims 18, 29, 31, 32, 33 and 34 have been amended. In view of these amendments, it is firmly believed that the present invention, and all the claims, are now in complete compliance with all the requirements

for the granting of a patent therefor. A prompt notification of allowability is respectfully requested.

Respectfully submitted,

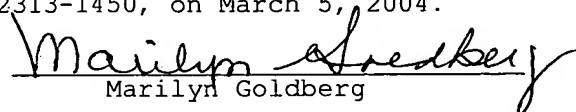
CHRISTOPH RÜDINGER (PCT) -5

COLLARD & ROE, P.C.  
1077 Northern Boulevard  
Roslyn, New York 11576  
(516) 365-9802

BY   
Allison C. Collard, Reg.No. 22,532  
Edward R. Freedman, Reg.No. 26,048  
Frederick J. Dorchak, Reg.No. 29,298  
Attorneys for Applicant

ERF: djp

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on March 5, 2004.

  
Marilyn Goldberg